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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,938	05/10/2006	John Persenda	0505-1062	5035
466 7590 12/23/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER HELVEY, PETER N.	
			ART UNIT 3782	PAPER NUMBER
			NOTIFICATION DATE 12/23/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/572,938

Applicant(s)

PERSENDA, JOHN

Examiner

PETER HELVEY

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-8, 10, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Malaspina* (US Patent No. 6,585,415) in view of *Midgley et al.* (US 5120138, hereinafter *Midgley*).

Malaspina discloses a series of bags (10) consisting of two faces joined together around their whole periphery, with the exception of one longitudinal edge, the bag having an opening (Fig. 4) emerging at said longitudinal edge, the two faces of the bag being welded to one another along two opposite lateral edges (28, 30), each face of the bag comprises a hem (16, 18) bordering said opening, in which is placed a non-elastic drawstring (20, 22), it being possible for each non-elastic drawstring to be grasped from the outside via at least one notch (12, 14) made through said hems, at least one face having, near said opening, at least one elastic band (24) joined to said face, overlapping the hem or fold, by two connection regions (ends) in such a way that the effective relaxed length of said elastic band between the two connection regions corresponds to the gap between the two connection regions on the bag; the elastic band (24) extends

across the whole width of the bag, from a first of the lateral edges to a second of the lateral edges; said elastic band is welded to the two faces of the bag at each of said two lateral edges (col. 2, ll., 50-55).

Malaspina does not expressly disclose said elastic band is further welded to the bag at an intermediate connection region, the intermediate connection region forming one of the two connection regions and being at a location spaced from the two lateral edges, resulting in the relaxed length between the two connection regions being shorter than the length of the longitudinal edge of said face of the bag as claimed by applicant but rather discloses the elastic band being welded solely at the ends.

However, *Midgley* teaches that welding an elastic band to a bag at end points only, continuously along the length, or intermittently are equivalents (col. 4, ll. 45-65).

At the time of the invention, it would have been obvious to a person having ordinary skill in the art to attach the elastic band taught by *Malaspina* intermittently instead of solely at the ends as taught by *Midgley* in light of *Midgley* teaching they were well known equivalents long before the invention was made (col. 4, ll. 45-65).

Malaspina as modified by *Midgley* discloses all limitations of the claim(s) as detailed above except does not expressly disclose the elastic band has a degree of elongation of less than 150%, and preferably of around 100%.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide elastic with whatever particular degree of elongation was desired, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Malaspina* in view of *Midgley* as applied to claims 1 and 2 above, and further in view of *McGlew et al.* (US Patent No. 6,164,824, hereinafter '*McGlew*') as applied to claim 3.

Malaspina as modified by *Midgley* discloses all limitations of the claim(s) as detailed above except does not expressly disclose part of the fold forms the abovementioned hem (16, 18) and extends beyond it by a skirt, said elastic band being joined to the corresponding face of the bag by overlapping said skirt at least partially.

However, *McGlew* teaches placing an elastic band in the extension or skirt of a fold forming a hem in the top of the bag is an equivalent alternative to placing both in the same hem, as taught by *Malaspina*.

Because *Malaspina* and *McGlew* both teach elastic band/drawstring/hem structures for the opening of a bag, it would have been obvious to one of ordinary skill in the art to substitute the double hem/skirt structure taught by *McGlew* for the single hem structure taught by *Malaspina* as modified by *Midgley* in view of *McGlew*'s teaching of equivalence (col. 4, ll. 17-27).

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Malaspina* in view of *Midgley* as applied to claim 1 above, and further in view of *Raterman* (US Patent No. 6,921,202).

Malaspina as modified by *Midgley* discloses all limitations of the claim(s) as detailed above except does not expressly disclose each elastic band is cut longitudinally into two vertically adjacent tapes.

The limitation "is cut longitudinally into two vertically adjacent tapes" is a product-by-process limitations and as such will be interpreted as requiring two vertically adjacent tapes, regardless of whether they are cut from the same original tape or not.

Raterman teaches providing multiple vertically adjacent elastic strands at the mouth of a trash bag.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second elastic band on the device taught by *Malaspina* as modified by *Midgley* in view of the teaching of *Raterman*, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cut the elastic band of *Malaspina* as modified by *Midgley* into two sections, since it has been held that constructing a

formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second elastic band on the device taught by *Malaspina* as modified by *Midgley*, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

5. Applicant's arguments with respect to claims 1-10 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER HELVEY whose telephone number is (571)270-1423. The examiner can normally be reached on M-Th 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. H./
Examiner, Art Unit 3782

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December 11, 2010

/Nathan J. Newhouse/
Supervisory Patent Examiner, Art Unit 3782